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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,395	08/04/2000	Dale A. Scholtens	06269-029001	1974
26211	7590	07/14/2004	EXAMINER	
FISH & RICHARDSON P.C. 45 ROCKEFELLER PLAZA, SUITE 2800 NEW YORK, NY 10111			ELALLAM, AHMED	
			ART UNIT	PAPER NUMBER
			2662	

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/632,395

**Applicant(s)**

SCHOLTENS ET AL.

**Examiner**

AHMED ELALLAM

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13,15-17 and 23-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,23-27 and 29-35 is/are rejected.
- 7) ☒ Claim(s) 28 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are two misnumbered claims 32.

Misnumbered claims 32, 32-35 been renumbered 32-36 respectively. Applicant is required to refer to these claim with the new numbering.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15-17, 23-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Focarile et al, US (5,434,854).

Regarding claims 16 and 23, with reference to figures 1 and 2, Focarile discloses a Method/software for providing telephone calls (claimed narrowband communication services) comprising:

Providing a soft handoff, in which Information (claimed traffic) coming from PSTN 46, are replicated and addressed for both cell site 14 and 16, the information is then packetized into ATM cells and sent through ATM network 22 to cell sites 14 and 16, wherein the soft handoff is carried after the transmission of the information to both cells 14 and 16. See column 6, lines 67-68 and column 7, lines 1-18. (Claimed rolling over a narrowband communication line that traverses a channel in a first virtual circuit connection in a packet network to a channel in a second virtual circuit connection in the packet network, wherein the rolling over includes broadcasting traffic from a narrowband circuit over the channels in the first and second virtual connections).

Examiner interpreted the connections from the PSTN across the ATM network to the different sites 14 and 16 as being the claimed channel in a first virtual circuit connection in a packet network to a channel in a second virtual circuit connection in the packet network, and the transmission of information to both cell sites as being the broadcasting of traffic from the narrowband over the channels the first and second virtual circuit connections).

Regarding claim 17, Focarile discloses that the hand off is carried out without the user perceptible clicks or discontinuities. See column 14-18. (Claimed rolling over the narrowband communication line to the channel in the second virtual circuit is transparent to end-users.

Regarding claims 26 and 29, with reference to figure 1, Focarile discloses removing the destination 14 from the speech handler 36 list and removing the call data from cell site 14. (Examiner interpreted the removal of the destination from the packet

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switch unit 28 and the call data from cell site 14 as being the claimed reassigning a telephone circuit from the channel in the first virtual connection to the channel in the second virtual connection, because the call is routed to the destination 44 over the second virtual connection, wherein the first connection is terminated (handover).

Regarding claim 15, Focarile discloses receiving traffic on both sites 14 and 16 (Examiner interpreted the receiving of traffic by the mobile 44 over the ATM network by through the second site 16 as being the claimed detecting packets at a receiving end of the channel in the second virtual circuit and interpreted the claimed packets contain information representative of an association between one of the channels and the narrowband circuit as part of the ATM packet because that the ATM packets have source and destination address (ATM standard). Examiner also interpreted the ability of receiving traffic by the mobile 44 over the second site as being the claimed step of establishing a path from the receiving end of the channel in the second virtual connection to the narrowband circuit, and finally Examiner interpreted the handoff from the first virtual connection as being the claimed releasing resources associated with a path from a receiving at end of the narrowband circuit to the channel in the first virtual circuit). See column 6, lines 67-68 and column 7, lines 1-18.

Regarding claim 24, Focarile discloses receiving traffic on both sites 14 and 16 (Examiner interpreted the receiving of traffic over the ATM network by the second site 16 as being the claimed detecting packets at a receiving end of the channel in the second virtual circuit and interpreted the claimed packets contain information representative of an association between one of the channels and the narrowband

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circuit as part of the ATM packet because that the ATM packets have source and destination address (ATM standard). Examiner also interpreted the ability of receiving traffic by the second site as being the claimed step of establishing a path from the receiving end of the channel in the second virtual connection to the narrowband circuit). See column 6, lines 67-68 and column 7, lines 1-18.

Regarding claim 25, Examiner interpreted the handoff to the second connection as being the claimed releasing resources associated with a path from a receiving end of the narrowband circuit to the channel in the first virtual circuit connection. See column 6, lines 67-68 and column 7, lines 1-18.

Regarding claims 27 and 30, Focarile discloses with reference to figure 1, the mobile 44 requests a handoff from cell site 14 to cell site 16. (Examiner interpreted the handoff request as being the claimed rolling over occurs in response to receiving a request to reassign the narrowband circuit from the channel in the first virtual circuit connection to the channel in the second virtual circuit connection).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13 and 32-35 (renumbered claims) are rejected under 35 U.S.C. 103(a) as being unpatentable over Focarile in view of Hosein, US (6,728,272).

Regarding claim 13, Focarile discloses substantially all the limitation of the parent claim 16, except it does not specify that the narrowband communication line is a private line.

However, Hosein discloses in the same field of endeavor providing narrowband private lines communications over an ATM network. See figure 1, column 2, and lines 47-64.

Therefore, it would have been obvious to an ordinary person of skill in the art at the time the invention was made to have the narrowband communication lines of Focarile consist of private lines as indicated by Hosein so that the invention of Focarile can be extended to private lines. The advantage would be more subscribers to the network of Focarile.

Regarding claim 32, with reference to figures 1 and 2, Focarile discloses an apparatus including a switch 24 (claimed gateway) interposed between a PSTN 46 and an ATM network 24, wherein the switch is adapted to receiving narrowband information coming from the PSTN 46 or telephone 218, and replicating and addressing the received narrowband information for both cell site 14 and 16, the information is then packetized into ATM cells and sent through ATM network 22 to cell sites 14 and 16, wherein a soft handoff is carried after the transmission of the information to both cells 14 and 16. See column 6, lines 67-68 and column 7, lines 1-18. (Claimed gateway adapted to roll over a line that traverses a channel in a first virtual connection in a packet network to a channel in a second virtual circuit connection in the packet network,

wherein the rolling over includes broadcasting traffic from a narrowband circuit forming part of the line over the channels in the first and second virtual connections).

Examiner interpreted the connections from the PSTN across the ATM network to the different sites 14 and 16 as being the claimed channel in a first virtual circuit connection in a packet network to a channel in a second virtual circuit connection in the packet network, and the transmission of information to both cell sites as being the broadcasting of traffic from the narrowband circuit forming part of the line over the channels in the first and second virtual circuit connections).

Focarile does not disclose that the narrowband information is a private line information.

However, Hosein discloses in the same field of endeavor providing narrowband private lines communications over an ATM network. See figure 1, column 2, and lines 47-64.

Therefore, it would have been obvious to an ordinary person of skill in the art at the time the invention was made to have the narrowband communication lines of Focarile consist of private lines as taught by Hosein so that the invention of Focarile can be extended to private lines. The advantage would be more subscribers to the network of Focarile.

Regarding dependent claim 33, Focarile discloses transmitting traffic from both sites 14 and 16 (Examiner interpreted the transmission of traffic over the ATM network by the second site 16 as being the claimed detecting packets at a receiving end of the channel in the second virtual circuit and interpreted the claimed packets contain



information representative of an association between one of the channels and the narrowband circuit as part of the ATM packet because that the ATM packets have source and destination address (ATM standard). Examiner also interpreted the ability of receiving traffic by the switch from the second site 16 as being the claimed step of establishing a path from the receiving end of the channel in the second virtual connection to the narrowband circuit). See column 6, lines 67-68 and column 7, lines 1-18.

Regarding claim 34, Examiner interpreted Focarile handoff to the site 16 from site 14 by the switch 24 as being the claimed gateway is adapted to release resources associated with a path from a receiving end of the narrowband circuit to the channel in the first virtual circuit connection).

Regarding claim 35, Focarile discloses that the ECP (Executive Call Processor) that inform speech handler 36 (located at the switch 24) to transmit data to both cells 14 and 16. See column 6, lines 54-56. (Examiner interpreted informing the speech handler to transmit data to both site before the handoff takes place as being the claimed gateway is adapted to perform the rolling over in response to receiving a request to reassign the narrow band circuit from the channel in the first virtual circuit connection to the channel in the second virtual connection).

***Allowable Subject Matter***

4. Claims 28 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. Applicant's arguments with respect to claim 16, 23 and 32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hosein, US (6,658,008) and Hosein, US (6,735,191).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (703) 308-6069. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM  
Examiner  
Art Unit 2662  
July 1, 2004

  
**JOHN PEZZLO**  
**PRIMARY EXAMINER**